

REMARKS

Claims 1-36 and 39-41 are pending. No claim has been amended.

In the Official Action, claims 1-36 and 39-41 were rejected as allegedly being obvious under 35 U.S.C. § 103(a) over Boyd (US 2002/0194049) and Hanson et al. (USP 6,691,153). This rejection is respectfully traversed for failure to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, patent examiners are required to establish three criteria: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference, or combination of references, must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. §§ 2143 - 2143.03. To make a proper obviousness determination, the patent examiner must “step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.” M.P.E.P. § 2142. In view of the available factual information, the patent examiner must make a determination as to whether the claimed invention “as a whole” would have been obvious at that time to that person skilled in the art. Importantly, a rejection based on these criteria must be based on what is taught in the prior art, not the applicant’s disclosure. The applicant’s disclosure may not be used as a blueprint from which to construct an obviousness rejection. *Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985); *Orthopedic Equipment Company v. United States*, 702 F.2d 1005, 1012 (Fed. Cir. 1983); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 (Fed. Cir. 1985); *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996). The patent examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. The Examiner has not met this burden in this case.

First, there is no reason in the cited references and no suggestion or motivation provided by the Examiner to combine the teachings of the cited references. The Examiner merely alleges that Boyd and Hanson are “from the same field of endeavor” and that it would have been obvious to one skilled in the art to incorporate the image server of Hanson in the

web server of Boyd. Applicant can find no suggestion or motivation for this combination and the Examiner has provided none.

Second, even if the Examiner could find a motivation for the combination, the combination falls far short of suggesting the claimed invention. Neither reference discloses a chat environment and neither reference discloses a chat environment including “an area for chat messages, a plurality of screen images, each one of the plurality of screen images associated with a corresponding one of the chat participants, and a plurality of compatibility indicator sets, each one of the indicator sets associated with a corresponding one of the chat participants” as claimed.

On the contrary, Boyd teaches a network service where users may post notices for a meeting at a particular place and time and receive responses via email, phone, beeper, and the like accepting the meeting. The invitations may be categorized by criteria (paragraphs [0049] and [0055] on page 5) to facilitate searching by those interested in responding. A person reviewing invitations may check the personal pages in a profile database of the persons posting meeting notices before accepting. The system may account for user interests (paragraph [0061] on page 6) and personality traits (paragraph [0065] on page 6) in a static manner but specifically disclaims the notion that the system may be used as a “dating service” (paragraph [0067] on page 6). Nothing in the Boyd disclosure suggests the system includes a chat service, particularly one that identifies the compatibility of other chat participants.

The teachings of Hanson are even less relevant. Hanson teaches providing a “dynamic content region” in an electronic medium so that changing (dynamic) content may be incorporated into a “process interaction.” Nothing in the Hanson patent suggests the system includes a chat service, particularly one that identifies the compatibility of other chat participants.

Accordingly, the Examiner has not established *prima facie* obviousness because there is no suggestion or motivation to combine the teachings of the references and because the references separately or together do not teach a chat service, particularly one that identifies the compatibility of other chat participants. Also, Boyd teaches that his invention is NOT for a dating service and thus specifically teaches away from the claimed invention. In view of these shortcomings in the obviousness rejection, withdrawal of the rejection of claims 1-36

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and 39-41 is requested.

Conclusion

The present application is believed to be in condition for allowance. A Notice of Allowability is respectfully solicited.

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